UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,857	11/16/2000	William L. Jansen	44439.1.8.1	5894

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EXAMINER
MYHRE, JAMES W

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/714,857	JANSEN ET AL.
	Examiner	Art Unit
	James W Myhre	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 September 2004_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-3,7,8,14-18,20 and 22-32_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-3,7,8,14-18,20 and 22-32_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _20040715 (9 pgs)_ .

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   The amendment filed on September 30, 2004 is sufficient to overcome the 35

U.S.C. 102 rejection as being anticipated by Biorge et al (5,806,045) and the 35 U.S.C.

103 rejections as being obvious over Biorge in view of Eggleston et al (6,061,660) and

Storey (5,774,870). The amendment canceled Claims 4-6, 9-13, 19, and 21; amended

Claims 1-3, 7, 8, 14-17, 20, and 22-25; and added new Claims 26-32. Therefore, the

currently pending claims considered below are Claims 1-3, 7, 8, 14-18, 20, and 22-32.

Information Disclosure Statement

2.   The information disclosure statement filed July 15, 2004 fails to comply with the

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not list the inventor's

name of each reference cited. However, since the Applicant submitted papers which

supposedly corresponded to the cited references, but only contained an abstract for

each, the Examiner has reviewed and considered these abstracts, but not the entire

references. If it is desired to have the entire references considered, the Applicant is

advised to resubmit the Information Disclosure Statement in proper format in

accordance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Applicant is

advised that the date of any re-submission of any item of information contained in this

information disclosure statement or the submission of any missing element(s) will be the

date of submission for purposes of determining compliance with the requirements based

on the time of filing the statement, including all certification requirements for statements

under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1). Additionally, pages 7-10 of the 1449

form were missing.

Claim Objections

3.   Claim 26 is objected to because of the following informalities: in the second line

the word "royalty" should be "loyalty". Appropriate correction is required.

4.   Claims 27-32 are dependent upon Claim 23, which is a "computerized system".

Claims 27-32 all refer to "The computerized method ... as claimed in claim 23". The

word "method" in the first line of each of these claims should be changed to "system".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-3, 7, 8, 14-18, 20, and 22-32 are rejected under 35 U.S.C. 102(b) as

being anticipated by Postrel (6,594,640).

       Claim 1: Postrel discloses a method for tracking and converting loyalty points

from a plurality of loyalty programs, comprising:

a. Obtaining the number of loyalty program award points awarded to a user under a plurality of loyalty programs (col 1, lines 14-29 and col 3, lines 30-40 and 58-60);

b. Converting the user's award points from the plurality of loyalty programs into a common credit (col 3, lines 30-40; col 9, lines 10-12; and col 10, lines 18-20);

c. Providing access to a retailer that provides discounts based on the common credit (col 7, lines 1-41);

d. Calculating the discount off the price of a selected product or service offered by the retailer (col 7, lines 1-41); and

e. Applying the discount to the price of the product or service purchased by the user (col 7, lines 1-41).

Claim 2: Postrel discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses obtaining information about the loyalty programs prior to obtaining the award points (col 7, line 42 – col 8, line 3).

Claim 3: Postrel discloses a method for tracking and converting loyalty points as in Claim 2 above, and further discloses that the information is obtained from the user through an interactive communication (col 6, lines 1-52).

Claim 7: Postrel discloses a method for tracking and converting loyalty points as in Claim 3 above, and further discloses using the payment information to complete the purchase (col 6, lines 1-52 and col 7, lines 25-41).

Claim 8: Postrel discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses updating the user's credit balance after the purchase of the product or service (col 6, lines 1-52 and col 7, lines 25-41).

Claim 14: Postrel discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses displaying the current status of the user's credits to the user (col 8, line 65 – col 9, line 1).

Claim 15: Postrel discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses updating the award points in the plurality of loyalty programs (col 7, lines 25-41).

Claim 16: Postrel discloses a method for tracking and converting loyalty points as in Claim 15 above, and further discloses updating the award points as a batch communication with the remote server in that all of the accounts will be updated at the same time (col 7, lines 25-41).

Claim 17: Postrel discloses a method for tracking and converting loyalty points as in Claim 16 above, and further discloses verifying (confirming) the award points (col 7, lines 14-19).

Claim 18: Postrel discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses providing information about products or services for sale to the user via communication with the retailer (col 7, lines 1-10).

Claim 20: Postrel discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses that the user registers on-line (col 6, lines 10-12 and col 8, lines 4-26).

Claim 22: <u>Postrel</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses converting the award points into a proportionate number of system-wide credits (conversion rate)(col 9, lines 9-12 and col 10, lines 18-20).

Claim 23: <u>Postrel</u> discloses a system for tracking and converting loyalty points, comprising:

    a. A database for maintaining credit balances of a user (Figure 5, item 54);

    b. An interactive communication link to a loyalty program to which the user has subscribed (Figure 5 and col 5, lines 3-60);

    c. An interactive communication link to at least one vendor of a product or service (Figure 5 and col 5, lines 3-50); and

    d. Computerized means for reducing the credit balance approximately proportional to a discount offered by the vendor (col 5, lines 3-50).

Claim 24: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses linking to a plurality of loyalty programs (col 5, lines 3-50).

Claim 25: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses linking to a plurality of products or services that the user may purchase (col 5, lines 3-50).

Claim 26: <u>Postrel</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses enabling the user to receive loyalty points from a selected loyalty programs (col 7, lines 45-61).

Claim 27: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses enabling the user to select the number of credit from each of the plurality of loyalty programs to redeem as common credits (col 7, line 1 – col 8, line 3).

Claim 28: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses the points for each of the plurality of loyalty programs being stored as separate files showing the current balance therein (col 7, line 1 – col 8, line 3).

Claim 29: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses the merchant is enabled to determine whether the transaction is eligible to be exchanged for the common credits (col 7, lines 1-41).

Claim 30: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses the vendor setting the value of the product in common credits (col 7, lines 1-41).

Claim 31: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses one of the servers calculating the number of common credits needed to achieve a desired discount for the user (col 7, lines 1-41).

Claim 32: <u>Postrel</u> discloses a system for tracking and converting loyalty points as in Claim 23 above, and further discloses displaying to the user the number of common credits needed to satisfy the transaction (col 8, line 65 – col 9, line 1).

Response to Arguments

7.   Applicant's arguments with respect to claims 1 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
December 10, 2004

James W. Myhre
Primary Examiner
Art Unit 3622